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No. 77-683

In the

Supreme Court of the United States

OCTOBER TERM, 1977

MILLER BREWING COMPANY,

Petitioner,

vs.

G. HEILEMAN BREWING COMPANY, INC.,

Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION

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Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION

OPINIONS BELOW

The Decision of the United States Court of Appeals for the Seventh Circuit is reported at 561 F.2d 75.

ADDITIONAL STATUTORY PROVISIONS INVOLVED

28 U.S.C. §1292(a)(1):

> §1292. *Interlocutory decisions*
>
> (a) The courts of appeals shall have jurisdiction of appeals from:
>
> (1) Interlocutory orders of the district courts of the United States, the United States District Court for the District of the Canal Zone, the District Court of Guam, and the District Court of the Virgin Islands, or of the judges thereof, granting, continuing, modifying, refusing or dissolving injunctions, or refusing to dissolve or modify injunctions, except where a direct review may be had in the Supreme Court; . . . .

28 U.S.C. §2106:

§2106. *Determination*

The Supreme Court or any other court of appellate jurisdiction may affirm, modify, vacate, set aside or reverse any judgment, decree, or order of a court lawfully brought before it for review, and may remand the cause and direct the entry of such appropriate judgment, decree, or order, or require such further proceedings to be had as may be just under the circumstances.

QUESTIONS PRESENTED

1. Whether on the basis of the record before it and in the context of the arguments asserted by Petitioner, the Court of Appeals in concluding as a matter of law that "light" is a "generic" or "common descriptive" word when applied to "beer", so far departed from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of supervision?

2. Whether in concluding as a matter of law that the word "light" is a "generic" or "common descriptive" name, term or word when applied to or used with "beer" created a "new legal standard" which should be reviewed by this Court?

3. Whether the Court of Appeals' decision that petitioner was not entitled to the statutory benefits of registration under 15 U.S.C. §1115(a) warrants this Court's review?

SUPPLEMENTAL STATEMENT OF THE CASE

Prior to bringing its motion to preliminarily enjoin Respondent G. Heileman Brewing Company ("Heileman"), Petitioner Miller Brewing Company ("Miller") had sued

three other brewers[1] on virtually identical complaints to the one filed against Heileman. Although the three prior actions had been pending for approximately one year at the time Heileman was sued, and although Miller had developed an extensive discovery record on at least one of those actions (the one against Schlitz), Miller had not moved (and has yet to move) for a preliminary injunction against any one of those brewers.

On November 2, 1976, simultaneously with the filing of its complaint against Heileman, Miller filed a motion to preliminarily enjoin Heileman "from offering to sell, advertising or distributing beer during this action under the brand name, or under a brand name incorporating the word 'Light', and the word 'Lite', or any colorable imitation of either word". Accompanying the motion were the voluminous affidavits of five persons, some of which incorporated information which had been prepared for or obtained in the Schlitz litigation. On November 15, 1976, pursuant to the District Court's order, Heileman submitted its responsive papers, which included the affidavit of its President, Russell G. Cleary, reviewing some of the history of the use of the word "light" by brewers and others, and the affidavit of one of its attorneys, which incorporated portions of deposition testimony taken in the Schlitz litigation.

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[1] *Miller Brewing Company* v. *Genesee Brewing Co., Inc.* (U.S.D.C. S.D.N.Y., Case No. 75 Civ. 5443), filed October 31, 1975; *Miller Brewing Company* v. *Peter Hand Brewing Company* (U.S.D.C. N.D.Ill., Case No. 75-C-3573), filed October 31, 1975; and *Miller Brewing Company* v. *Jos. Schlitz Brewing Company* (U.S.D.C. E.D.Wis., Case No. 75-C-636), filed October 31, 1975 (hereinafter "Schlitz litigation").

By Opinion and Order dated January 21, 1977 (Petitioner's Appendix B 20), the District Court granted plaintiff's motion and preliminarily enjoined Heileman "from the continued sale, advertising, and distribution of beer anywhere in the United States, under the brand name incorporating the word "Light" in the manner of the label attached to the complaint herein as Exhibit E, and under any colorable imitation of the following labels and designs registered on the principal register of the United States Patent Office: No. 905,236 (December 29, 1970); No. 929,276 (February 15, 1972); and No. 929,277 (February 15, 1972), as amended June 3, 1975."[2]

Heileman then moved the District Court to vacate the injunction on several alternative grounds. By Opinion and Order dated February 22, 1977 (Petitioner's Appendix C), the District Court denied Heileman's motion.

The District Court's Orders of January 21, 1977, and February 22, 1977, were both grounded on the erroneous legal conclusion that the word "light" was neither a "generic" *or "common descriptive" word* when applied to beer which is low in calories and therefore it could be monopolized by Miller (Petitioner's Appendix B11, footnote 10). The District Court ignored the clear and uncontradicted evidence in the record which demonstrated *as a matter of law* the generic use of the word "light" in reference to beer *even prior* to Meister Brau's use.

Thereafter Heileman sought and obtained an expedited appeal to the Court of Appeals.

In a document entitled "Response To Appellant's 'Emergency Motion For An Order Suspending Preliminary Injunction During Pendency Of Appeal, And An Expedited Briefing Schedule'", Miller stated, *inter alia*: (¶ No. 2)

> An authoritative ruling on some of the issues raised by Appellant seems likely to affect and shorten the course of several other pending litigations.

In its principal brief ("Appellee's Brief") to the Court of Appeals, Miller, in arguing the issue of whether the word "light" was "generic", argued that the case of *Abercrombie & Fitch Co.* v. *Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976) "set forth the law . . . with precision, scholarship and clarity" (Appellee's Brief, at 12).[3] Further, Miller advanced the following definition of "generic" (Appellee's Brief, at 18):

> Generic means of or pertaining to a genus.
>
> The definition of "genus" is
>
> > "a class, kind or group marked by common characteristics or by one common characteristic." Webster's Third New International Dictionary (Unabridged ed. 1966).

In responding to Heileman's (and, *amicus curiae* Schlitz')[4] argument, that if the Court of Appeals had any doubt that the word "light" was generic as applied to beer, it should vacate the injunction and permit an evidentiary hearing on the issue of whether the word had since become "generic" for "low calorie" beer (*see* Petitioner's

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[2] Hereinafter the "Meister Brau registrations".

[3] Both Heileman and Miller agreed in their respective briefs filed in the Court of Appeals that this case properly set forth the four categories under the Lanham Act, to wit: (1) generic or common descriptive; (2) merely descriptive; (3) suggestive; and (4) arbitrary or fanciful. (*See, e.g.*, Petition at 4-5) The Court of Appeals agreed (Petitioner's Appendix, A7).

[4] Schlitz and Peter Hand Brewing Co. sought and obtained the right to file, and then each filed, a brief *amicus curiae*.

Appendix B24-B25).[4] Miller responded as follows (Appellee's Brief, at 53, emphasis added):

> Both Heileman . . . and Schlitz . . . note that the injunction was issued on affidavits and after a lengthy non-evidentiary hearing. Heileman did not seek an evidentiary hearing at the time, and has yet to suggest what such a hearing would have produced; *there is no significant fundamental fact in dispute.*[5]

The Court of Appeals, after considering the undisputed evidence submitted to the District Court, other information properly subject to judicial notice, and the arguments presented by the respective parties concluded as a matter of law, *inter alia,* that the word "light", when applied to beer, was a "common descriptive" or "generic" word, term or name and therefore not subject to monopolization by Miller.

---

[4] An issue which in Heileman's view needed to be addressed only if the Court rejected its first position, *i.e.*, that the undisputed evidence of record established as a matter of law that prior to and at the time of Meister Brau's adoption and use of "Lite" the word "light" was generic when used with or applied to beer in general and that "low calorie" beer fell within this generic usage.

[5] In opposing consolidation before the Multidistrict Panel, Miller made the following assertions: (emphasis added)

> Most defendants will probably rely on the history of prior use of "light" in the brewing industry. Again, *there is virtually no dispute as to the fundamental facts, but sharp disagreement as to the conclusions to be drawn therefrom.* (Statement and Brief of Miller Brewing Company Opposing Transfer To A Single District, at 9-10)
>
> • • •
>
> The Heileman appeal is about to be argued. . . . The decision on that appeal could be a major step in resolving many or all of the "Lite Beer" cases. (*Id.*, at 15)

ARGUMENT

I. INTRODUCTION

Before commenting on the arguments raised in Miller's Petition, it is appropriate to comment on what Miller does *not* argue. First, it does not (now) argue that the Court of Appeals erred in reversing the District Court's improvidently granted motion for preliminary injunction: it only argues that in so doing the Court of Appeals "went too far". Second, it does not (now) argue (as it did in the Court of Appeals) that the record it presented herein affirmatively establishes the word "light" is *not* "generic"; it only (now) argues that this issue is one of "fact" and that it is entitled to an evidentiary hearing on the "public understanding" test (Petition, at 6).

II. IN CONCLUDING AS A MATTER OF LAW THAT THE WORD "LIGHT" IS A "GENERIC" OR "COMMON DESCRIPTIVE" NAME, TERM OR WORD WHEN APPLIED TO OR USED WITH "BEER", THE COURT OF APPEALS DID NOT DEPART FROM THE ACCEPTED AND USUAL COURSE OF JUDICIAL PROCEEDINGS AS TO CALL FOR THE EXERCISE OF THIS COURT'S POWER OF SUPERVISION.

A. The Facts Relied Upon By The Court Of Appeals Are Established Of Record Or Properly Subject To Judicial Notice, Are Uncontradicted And Indisputable, And Establish As A Matter Of Law That "Light" As Applied To Beer Is "Generic"; Accordingly The So-Called "Public Understanding" Issue Was Never Reached And Need Not Be Reached.

Miller claims that the Court of Appeals erroneously "substituted its judgment for that of the District Court

on a factual issue as to which neither litigant had developed more than the preliminary record normal for hearings of preliminary injunction motions" (Petition, at 9). The factual issue referred to, apparently, is the question put by Judge Hand in the *Bayer*[7] case, to wit:

"What do the buyers understand by the word for whose use the parties are contending?" Miller contends that "[n]one of the facts . . . upon which the Court of Appeals relied in vacating bore more than incidentally on "public understanding" (Petition, at 6).

This argument is based on Miller's erroneous legal view of the facts upon which the Court of Appeals relied, attempts to create a factual issue on an issue which is not "material", and accordingly, has no merit.

In holding that the word "light" as used by Heileman is or was generic, the Court of Appeals stated as follows:

> The record before us (although less complete than that in at least one of the other pending cases . . .)[8] and facts of which we may take judicial notice, including generally accepted English usage, enable us to conclude that "light" is a generic or common descriptive term when used with "beer" (Petitioner's Appendix, A9).

It is clear from the Court's careful choice of the word "conclude" that it viewed the classification of the word

[7] *Bayer Co.* v. *United Drug Co.* (S.D.N.Y. 1921), 272 F. 505, 509. There "Aspirin" was originally an arbitrary and fanciful trademark. Whether it became generically descriptive of sodium acetyl salicylate through public usage was truly a fact issue.

[8] The Court's footnote referred to Schlitz' (not Miller's) contention that the record in the Schlitz litigation was more complete.

"light" (in the context of the undisputed and indisputable record presented) as a question of law—which it properly is. In support of this "conclusion" the Court of Appeals recited dictionary definitions and made reference to similar definitions and usage found in reference works on chemical technology, industry publications, magazines, newspapers, and state statutes, all of which were made a part of the record, and all of which demonstrate *as a matter of law* common and ordinary usage of the word "light" to name or designate a *kind* or *type* of beer, having a common characteristic and/or several common characteristics (*Id.*)[9] *i.e.*, that it is "generic" when used with or applied to beer.

In this context, it is hard to understand precisely what Miller's challenge is. Does it suggest that ordinary meaning and common usage of the word, as established through the evidence referenced has no bearing on the issue of whether the word is "generic"? If this is Miller's suggestion, it is clearly erroneous. As stated in VANDENBURGH, *Trademark Law and Procedure* (2d Ed., 1968), §9.20, at 270-71 (citations omitted):

> The manner in which the alleged mark has been used in magazines, newspapers, books, dictionaries, patents and other publications, is significant as to how it is regarded by the writers thereof.

See generally, 3 CALLMAN, *The Law Of Unfair Competition, Trademarks and Monopolies* (3d Ed.) §74.1, at 224-25 (footnotes omitted):

[9] We will not burden this Court with a recitation of this evidence. Suffice it to say that Miller does not now challenge, and has never challenged, this evidence. Its only response has been the "legal" argument that such evidence does not demonstrate that the word is or ever was "generic" for "low calorie" beer.

> As a general rule, a common word can never transcend the limitations of a common mark if it's used in its ordinary meaning and is applied to a proper subject.

"Ordinary meaning" and "common usage" are obviously established by the undisputed evidence referenced by the Court of Appeals.

Thus, Miller's point appears to be more limited, *i.e.*, that the evidence of record does not authoritatively establish that the public calls "*low calorie*" beer "light beer". Although Heileman urged the District Court to find on the basis of evidence of usage in trade publications, in magazines, in newspapers, and in the industry, that the "public" calls "low calorie" beer "light beer" (Petitioner's Appendix B24-B25), and although Miller never put in any evidence that the public called such products by any other name, this issue was not reached by the Court of Appeals. Rather it concluded on the basis of the *undisputed* evidence that the word "light" was "generic" when applied to "low calorie" beer even *prior to Meister Brau's use of the word "lite"*. As the Court of Appeals stated (Petitioner's Appendix A 11-12):

> Miller argues that it uses the word as the name for "less filling, low calorie" beer, and that "light" has not heretofore been used in that sense. This argument fails for two reasons. First, "less filling" means essentially light in body and taste and not oppressive to the stomach, which is a common descriptive meaning of "light"; and, as Miller conceded in its brief, the caloric content of beer depends primarily on alcoholic content. . . . Second, even if Miller had given its light beer a characteristic not found in other light beers, it could not acquire the exclusive right to use the common descriptive word "light" as a trademark for that beer. Other brewers whose beers have qualities that make them "light" as that word has commonly been used remain free

> to call their beer "light". Otherwise a manufacturer could remove a common descriptive word from the public domain by investing his goods with an additional quality, thus gaining the exclusive right to call his wine "rosé," his whiskey "blended," or his bread "white."

These are legal conclusions based on undisputed evidence —they are not "findings of fact". As Miller itself has said (*see* footnote 6, *supra*):

> [T]here is virtually no dispute as to the fundamental facts, but sharp disagreements as to the conclusions to be drawn therefrom.

In sum, the so-called "public understanding" issue did not have to be addressed by the Court of Appeals. Miller's argument (Petition, at 9) that the "Court of Appeals substituted its judgment for that of the District Court on a factual issue as to which neither litigant had developed more than the preliminary record normal for hearings of preliminary injunction motions" is not supportable in reference to the facts relied on by the Court of Appeals and demonstrates a blatant misreading of the Court of Appeals' decision.

B. The Issue Resolved By The Court Of Appeals Being One Of Law, It Was Appropriate For It To Finally Resolve Such Issue In The Appeal, Particularly In The Context Of The Arguments And Positions Advanced By Miller.

Miller urges (Petition, at 8-9) that "Courts have repeatedly held that the outcome of a motion for preliminary injunction cannot control the ultimate merits of a cause except under the most extraordinary circumstances."[10]

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[10] If Miller is right in this contention then its Petition to this Court is premature. For the reasons stated herein, however, Heileman submits that Miller is wrong.

Heileman does not challenge the authority cited by Miller. However, Miller's arguments and citations do not fully state the law. Miller ignores equally well-settled principles which clearly demonstrate the propriety of the Court of Appeals making conclusions on the legal issues presented.

28 U.S.C. §2106 states as follows:

> The Supreme Court or any other court of appellate jurisdiction may affirm, modify, vacate, set aside or reverse any judgment, decree, or order of a court lawfully brought before it for review, and may remand the cause and direct the entry of such appropriate judgment, decree, or order, or require such further proceedings to be had as may be just under the circumstances.

In commenting on the scope of review intended by this section, Professor Moore states as follows (footnotes omitted):

> . . . Once a timely appeal is taken from an order made appealable by statute, the power of a court of appeals should be plenary to the extent that it chooses to exercise it. A court should not close its eyes to what is plainly there. To read 28 USC § 2106 in a technical way is to defeat its purpose. The spirit of the decision of the Second Circuit in *Hurwitz* v. *Directors Guild of America, Inc.* [(2d Cir., 1966) 364 F.2d 67, cert. denied (1966) 385 US 971, 87 S. Ct. 508, 17 L.Ed.2d 67.], deserves wide diffusion. In *Hurwitz,* an appeal was taken from an order denying a preliminary injunction. Persuaded by its study of the record that the plaintiffs were entitled to judgment on the admitted facts as a matter of law, the court of appeals reversed with instructions to grant a permanent injunction. To be sure, the circumstances were unusual, but the decision stands for the larger, very salutary proposition that once a case is lawfully before a court of appeals, it does not lack power to do what plainly

> ought to be done. . . . 9 MOORE'S FEDERAL PRACTICE (1975) ¶110.25[1], at 273.

In commenting on the review under 28 U.S.C. §1292(a)(1), another authority states as follows (footnotes omitted):

> . . . [I]f an interlocutory appeal is taken, the appellate court may consider the merits of the case, to the extent they relate to the propriety of granting the injunctive relief and under unusual circumstances may dismiss the action if an insuperable obstacle to awarding relief becomes apparent. 11 WRIGHT AND MILLER, FEDERAL PRACTICE AND PROCEDURE (1973), §2962, at 629.

The same authority later comments as follows (footnotes omitted):

> . . . [I]f the lower court's decision rests on an interpretation of the law rather than on the facts, the appellate court is not as limited in its review and may reverse if it feels that the lower court's review of the law was erroneous. As stated. by one court, "the trial court abuses its discretion when it fails or refuses properly to apply the law to conceded or undisputed facts." [quoting from *Clemons* v. *Board of Educ. of Hillsboro, Ohio* (6th Cir. 1956) 228 F.2d 853, 857, cert. den. 350 U.S. 1006] *Id.,* at 636-37.

Thus, as Professor Moore states (footnotes omitted):

> The issues before the district court at the preliminary injunction stage may be such that its order, or, if the order is reviewed, the appellate court's order is conclusive of the action. 7 MOORE'S FEDERAL PRACTICE (1975), ¶65.21, at 65-157.

Cases which have been "finally resolved" issues of law at the preliminary injunction stage (which resolution became the "death knell" to a litigant) are legion. *Cf., e.g., Youngstown Sheet & Tube Co.* v. *Sawyer* (1952), 343 U.S. 579, 584-85; *Deckert* v. *Independence Shares Corp.* (1940), 311

U.S. 282, 287; *Mecanno Ltd.* v. *John Wanamaker* (1920), 253 U.S. 136, 140-41; *Smith* v. *Vulcan Iron Works* (1897), 165 U.S. 518, 525-26; *CES Pub. Corp.* v. *St. Regis Publications, Inc.* (2d Cir. 1975), 531 F.2d 11 (wherein the Second Circuit concluded that the words "consumer electronics" were generic in the context of a review of a denial of a motion for preliminary injunction); *People of State of Cal. ex rel Younger* v. *Tahoe Regional Planning Agency* (9th Cir. 1975), 516 F.2d 215, *cert. den.* 423 U.S. 686; *Maryland-National Capital Park and Planning Commission* v. *U.S. Postal Service* (D.C. Cir. 1973), 487 F.2d 1029; *Delaware & Hudson Ry. Co.* v. *United Transp. Union* (D.C. Cir. 1971), 450 F.2d 603, 620; *cert. den.* 403 U.S. 911.

Accordingly, the Court of Appeals properly made the challenged conclusions in the case at bar and in so doing did not depart in any way from the "accepted and usual course of judicial proceedings". Indeed, in the context of the arguments and positions advanced to the Court of Appeals by Miller, and of the fact that two other cases involving the *same legal issues* are pending within its Circuit, it would have been remiss for it not to have done what it plainly ought to have done.

III. THE COURT OF APPEALS APPLIED WELL-ESTABLISHED PRINCIPLES IN CONCLUDING THAT "LIGHT" IS A "GENERIC" OR "COMMON DESCRIPTIVE" NAME OR WORD WHEN APPLIED TO "BEER".

Miller's second point seriously mischaracterizes the Decision of and the law applied by the Court of Appeals.

Under the law cited by the parties to the Court of Appeals, which law was properly applied by the Court

of Appeals, there are four categories in which a "name" or "word" or "designation" may potentially fall in considering whether such "name" or "word" or "designation" is entitled to trademark protection. As stated by the Court of Appeals (Petitioner's Appendix A7):

> A term for which trademark protection is claimed will fit somewhere in the spectrum which ranges through (1) generic or common descriptive and (2) merely descriptive to (3) suggestive and (4) arbitrary or fanciful.

Accord, Abercrombie & Fitch Co. v. *Hunting World, Inc.* (2d Cir. 1976), 537 F.2d 4, 9-11; *CES Pub. Corp.* v. *St. Regis Publications, Inc.* (2d Cir. 1975), 531 F.2d 11.

Miller appears to suggest to this Court that the Seventh Circuit erroneously equated the "common descriptive name" category in sections 14 and 15 of the Lanham Act (15 U.S.C. §§ 1064 and 1065, Petitioner's Appendix C2-C3)—which sections foreclose trademark significance to such "name(s)"—with the concept of "generic word", *i.e.*, words which under the common law were not entitled to any trademark significance. However, the equation made by the Seventh Circuit, is fully consistent with the structure of the Lanham Act and has been expressly made by other courts. Thus, in the *CES Pub. Corp.* case, *supra*, 531 F.2d at 13, the Second Circuit (Friendly, J.) made the following analysis (emphasis added):

> . . . Although the [Lanham] Act does not explicitly say that a *generic word* cannot be validly registered even if there is proof of secondary meaning, this is the necessary implication from the contrast between § 14(c) and § 15(4) on the one hand, which provide that a registered mark may be cancelled at any time if it becomes "the common descriptive name of an article or substance," and that "No incontestable right

> shall be acquired in a mark which is the common descriptive name of any article or substance, patented or otherwise," and §§ 2(e), (f) and § 15 on the other, which permit registration of "merely descriptive" marks if they have "become distinctive of the applicant's goods in commerce" and allow such marks to achieve incontestability. The reason is plain enough. To allow trademark protection for *generic terms*, i.e., names which describe the genus of goods being sold, even when these have become identified with a first user, would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are.

Prior to the Lanham Act, no distinction was made between the "generic" ("common descriptive") and "merely descriptive" categories: a word which was "generic" *or* "merely descriptive' was not protectable. *E.g., Abercrombie & Fitch Co.* v. *Hunting World, Inc., supra*, 537 F.2d, at 9:

> . . . A generic term is one that refers, or has come to be understood as referring, to the genus of which the particular product is a species. At common law neither those terms which were generic nor those which were merely descriptive could become valid trademarks, see *Delaware & Hudson Canal Co.* v. *Clark*, 80 U.S. (13 Wall.) 311, 323, 20 L.Ed. 581 (1872) ("Nor can a generic name, or a name merely descriptive of an article or its qualities, ingredients, or characteristics, be employed as a trademark and the exclusive use of it be entitled to legal protection").

Cf., Kellogg Co. v. *National Biscuit* (1938), 305 U.S. 111; *W. R. Warner Co.* v. *Eli Lilly & Co.* (1924), 265 U.S. 526. The Lanham Act, and specifically section 2(f) (15 U.S.C. §1052(f)), enacted the "merely descriptive" exception.[11]

[11] Providing registerability where "secondary meaning" can be shown.

However, as also stated in the *Abercrombie & Fitch* case, *supra*, 537 F.2d, at 9:

> . . . While . . . the Lanham Act makes an important exception with respect to those merely descriptive terms which have acquired secondary meaning, see § 2(f), 15 U.S.C. §1052(f), it offers no such exception for generic marks.

Although Miller attempts to set up some (unexplained) conflict between the Lanham Act category of "common descriptive name" and the common law category of "generic", when analyzed, this purported conflict has no substantive significance. *Miller does not argue that a generic word (as defined in the common law) is entitled to protection under the "merely descriptive" exception to the Lanham Act.* To the contrary, it concedes that "[g]eneric *words* may not become trademarks" (Petition, at 5). Thus, even under Miller's argument, if the Court of Appeals was correct in classifying "light" as "generic", it is not entitled to protection under the common law *or* under the Lanham Act.

When analyzed, all that Miller is really arguing to this Court is that it disagrees with the Court of Appeals classification of the word "light" as a "generic" word when applied to beer. Such an issue is not of sufficient importance to warrant this Court's review even though Miller advances the same self-serving argument in 10 other cases which may be affected by its present resolution.

In any event, for the reasons fully stated in the Court of Appeals Decision (Petitioner's Appendix A9-A12) Miller's argument lacks merit. Obviously a word which is descriptive of characteristics of a product *can also be "generic"*. Indeed, the very definition of "generic" advanced by Miller—"a class, kind or group marked *by*

common characteristics or by one common characteristic" —supports this conclusion. When the word "names", "designates" or "describes" *a kind, class* or *type* ("genus") of which the product is a "species" then, as applied to that product, it is "generic". *Abercrombie & Fitch Co.* v. *Hunting World, Inc., supra; CES Pub. Corp.* v. *St. Regis Publications, Inc., supra.* The Court of Appeals did not hold that the word "light" is generic because it is descriptive, as Miller charges (Petition, at 11). Rather it held, based on its review of the undisputed evidence, that the word "light" now describes (and has always described) a *kind, class*, or *type* of beer, to wit, a "light beer". Accordingly, Miller has no right to monopolize or to restrict the use of the word "light" as applied to beer.

IV. THE COURT OF APPEALS DECISION THAT PETITIONER WAS NOT ENTITLED TO THE STATUTORY BENEFITS OF REGISTRATION UNDER 15 U.S.C. §1115(a) DOES NOT MERIT THIS COURT'S REVIEW.

The Court of Appeals expressly followed the statutory criteria in considering the significance of the Meister Brau registrations. 15 U.S.C. §1057(b) provides in part as follows:

> §1057 Certificate of Registration—Issuance and Form. . . .
>
> (b) A certificate of registration of a mark upon the principal register provided by this Act shall be prima facie evidence of the validity of the registration, registrant's ownership of the mark, and of registrant's exclusive right to use the mark in commerce *in connection with the goods or services specified in the certificate, subject to any conditions and limitations stated therein.* (Emphasis supplied)

By its express terms, the trademark statute makes all registrations subject to any conditions and limitations in the certificate of registration and denies the statutory presumptions to marks which are not identical or to goods not actually specified.

The file wrappers of the three registrations establish *prima facie* the inapplicability of the registrations to Heileman's product. Beer with "2.8 grams of carbohydrates" (Miller's Lite Beer) is not a beer "with no available carbohydrates" (the goods described in Miller's predecessor registration). Accordingly, the statutory presumptions did not apply.

Miller cites (Petition, at 13) two Seventh Circuit decisions applying the so-called "product-extension doctrine" of trademark infringement. These same cases were cited to the Seventh Circuit in the appeal. This doctrine, however, has no application in a situation such as the case at hand, where the registrant "disclaimed by amending its applications for registration" (Petitioner's Appendix A6) the product extension now contended for. Furthermore, as shown above, "light" as applied by Heileman to beer was so clearly a generic use that the limited registrations were inapplicable.

In any event the Court of Appeals fairly observed (emphasis added):

> Thus, *although we think the result would be the same, whether or not § 1115(a)* applied, Miller's brand name "LITE" must be evaluated under the common law of trademarks without the benefit of registration (Appendix A6).

The conclusion from which Miller cannot escape is that regardless of whether the word "lite" or "light" is eval-

uated under common law principles or principles of statutory registration, as applied to beer, it is incapable of functioning as a trademark.

CONCLUSION

For the reasons stated, the Petition For A Writ Of Certiorari should be denied.

Respectfully submitted,

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